IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)
	)
Johnson et al.	) Art Unit: 2155
	)
Application No. 10/049,972	) Examiner: BATURAY, ALICIA
	)
Filed: 02/13/2002	) Date: 04/02/2007
	)
For: INTERNET JACK	)
	)
	)
	)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

REPLY BRIEF (37 C.F.R. § 41.37)

This Reply Brief is being filed within two (2) months of the mailing of the Examiner's Answer
mailed on 01/31/2007.

Following is an issue-by-issue reply to the Examiner's Answer.

<u>Issue # 1:</u>

The Examiner has rejected Claim 57 under 35 U.S.C. 112, first and second paragraphs, as failing to comply with the enablement requirement and for being indefinite.

   Group #1: Claim 57

The Examiner has maintained the rejection of Claim 57 under 35 U.S.C. 112, first paragraph, by simply reiterating that "[i]t is unclear how an Internet connection can be opened if the Internet is closed." Appellant again respectfully disagrees with such rejection, since appellant claims that "said <u>closure</u> of said Internet permits an Internet connection <u>only to a website</u> specified by said Internet-ready device" (emphasis added). It is thus readily apparent that appellant does not claim a "complete" closure, but rather a partial one that specifically permits an Internet connection only to a website specified by the Internet-ready device.

In the Examiner's Answer mailed 01/31/2007, the Examiner has argued that "the features upon which applicant relies (i.e., partial closure of the Internet) are not recited in the rejected claim(s) or disclosed in the specification or the drawings." The Examiner has further argued that "[i]t is unclear how an Internet connection can be opened if the Internet is closed" and has suggested 'that Appellant meant to state "the apparatus wherein said closure of said Internet <u>connection</u> permits <u>another</u> Internet connection…" or similar language.'

Appellant respectfully disagrees. First, appellant respectfully points out that page 9, lines 4-10 of the originally-filed specification, for example, clearly enables appellant's claimed technique "wherein said closure of said Internet permits an Internet connection permits an Internet connection only to a website specified by said Internet-ready device," as claimed. Of course, the above citation is set forth for illustrative purpose only and should not be construed as limiting in any manner.

Second, appellant respectfully asserts that appellant claims that the "Internet is closed <u>in that said user never intervenes</u> to provide additional information" (see Claim 12 for context-emphasis added) as well as that "said <u>closure</u> of said Internet permits an Internet connection <u>only to a</u>

<u>website</u> specified by said Internet-ready device" (see Claim 57-emphasis added), as claimed. Thus, it is again emphasized that the Examiner's arguments and interpretation of the claim term "closure" improperly *implies* that such term requires a "complete" closure, which is not the case. To the contrary, appellant's claim language itself *explicitly* requires that "said <u>closure</u> of said Internet permits an Internet connection <u>only to a website</u> specified by said Internet-ready device," where such emphasized language inherently defines a "partial" closure, not a "complete" one.

<u>Issue # 2</u>

The Examiner has rejected Claim 57 under 35 U.S.C. 112, second paragraph, as being indefinite.

  Group #1: Claim 57

The Examiner has maintained the rejection of Claim 57 under 35 U.S.C. 112, second paragraph, by simply reiterating that "[i]t is unclear how an Internet connection can be opened if the Internet is closed." Appellant again respectfully disagrees with such rejection, since appellant claims that "said <u>closure</u> of said Internet permits an Internet connection <u>only to a website</u> specified by said Internet-ready device" (emphasis added). It is thus readily apparent that appellant does not claim a "complete" closure, but rather a partial one that specifically permits an Internet connection only to a website specified by the Internet-ready device.

In the Examiner's Answer mailed 01/31/2007, the Examiner has argued that "the features upon which applicant relies (i.e., partial closure of the Internet) are not recited in the rejected claim(s) or disclosed in the specification or the drawings." The Examiner has further argued that "[i]t is unclear how an Internet connection can be opened if the Internet is closed" and has suggested 'that Appellant meant to state "the apparatus wherein said closure of said Internet <u>connection</u> permits <u>another</u> Internet connection…" or similar language.'

Appellant disagrees and respectfully asserts that appellant claims that the "Internet is closed <u>in that said user never intervenes</u> to provide additional information" (see Claim 12 for context-emphasis added) as well as that "said <u>closure</u> of said Internet permits an Internet connection <u>only</u>

-3-

to a website specified by said Internet-ready device" (see Claim 57-emphasis added), as claimed
Thus, it is again emphasized that the Examiner's arguments and interpretation of the claim term
"closure" improperly *implies* that such term requires a "complete" closure, which is not the case.
To the contrary, appellant's claim language itself *explicitly* requires that "said closure of said
Internet permits an Internet connection only to a website specified by said Internet-ready
device," where such emphasized language inherently defines a "partial" closure, not a
"complete" one.

Issue # 3:

The Examiner has rejected Claims 1-12, 18-38, and 44-57 under 35 U.S.C. 102(e) as being
anticipated by Vaziri (U.S. Patent No. 6,377,570).

Group #1: Claims 1-10, 12, 18-36, 38, 44-51, and 53-57

With reference to independent Claims 1 and 27, the Examiner has relied on the following excerpt
from Vaziri to make a prior art showing of appellant's claimed "protocol handler block for
receiving and handling messages from said user interface and from said Internet-ready device"
(see this or similar, but not identical language in each of the foregoing claims).

> "Checking and sending messages will now be explained with reference to
> FIGS. 7D and 7E. To check messages, the user dials #3 to enter message
> checking through the menu. The ISB connects to the ISP and then
> connects through ISP 706 and Internet 712 to POP server 716. Once this
> last connection is achieved, the ISB downloads and plays the first
> message. The user can then dial 1 to repeat, 2 to go to the next
> message or 3 to erase a message, much as he would with an answering
> machine. To send a message, the user dials #4, whereupon the ISB
> connects to the ISP and then connects through ISP 706 and Internet 712
> to SMTP server 718 (the function of the SMTP server having been
> described above). The user can then record a message and then send it
> via the SMTP server to the recipient's e-mail address. The ISB can be
> configured to impose a time limit on outgoing messages (e.g., 60
> seconds). The ISB can also be configured to poll the ISP periodically
> (e.g., four times a day or some other interval which is either set in
> the factory or programmed by the user) to check for message and to give
> an indication to the user via an LED or the like when messages are
> waiting.
>
> The ISB can also be configured to poll the ISP periodically (e.g., four
> times a day or some other interval which is either set in the factory

> or programmed by the user), whenever a call is completed over IP, or
> both to check for message and to give an indication to the user via an
> LED or the like when messages are waiting. In one configuration,
> polling takes place only when all three of the following conditions are
> satisfied: (1) the polling period set in the ISB has expired, (2) the
> telephone has not been in use in the last two minutes and (3) no ring
> signal has been received in the last two minutes. Of course, the ISB
> can be equipped with an internal clock, such as those used in
> conventional IBM-compatible PCs, to allow periodic polling.
>
> Each voice mail message is stored on the recipient's POP server in the
> form of an e-mail message with the sender's e-mail address listed in
> the "From:" field, a standard subject such as "ISB voice mail message"
> and a MIME attachment of the voice mail message in an appropriate sound
> file format. If the recipient checks his e-mail on the POP server with
> a conventional e-mail program such as Eudora, he will see such message
> interspersed among conventional e-mail messages. The ISB can
> distinguish the voice mail messages from the conventional e-mail
> messages by the subject." (Col. 17, line 57 – col. 18, line 33)

Appellant respectfully asserts that the above excerpt from Vaziri only relates to messages from a telephone, not an "Internet-enabled device," as claimed (again, note that the Examiner now relies on Vaziri's help desk computer to meet appellant's claimed "Internet-enabled device"). Further, the messages of the above excerpt do not relate to messages from a "user interface" of an "apparatus for a user to connect an Internet-ready device to the Internet," as claimed, especially since the messages in Vaziri are from a telephone, and not from the help desk computer, as relied on by the Examiner. Thus, in no way is there even a suggestion of any sort of "protocol handler block for receiving and handling messages from said user interface **and** from said Internet-ready device," in the manner claimed by appellant (emphasis added). Appellant asserts that such use of Vaziri as a dictionary (i.e. by relying on a help desk computer as an Internet-enabled device and then relying on the functionality of a telephone) is simply inappropriate, and is further evidence that the prior art of record simply does not meet appellant's claims.

In the Advisory Action mailed 03/30/2006, the Examiner again relied upon Col. 17, line 57 to Col. 18, line 33 in Vaziri to make a prior art showing of appellant's claimed technique. Further, the Examiner argued that "the messages are converted from phone messages to email messages that are capable of being received at the help desk computer." First, appellant respectfully disagrees with the Examiner's statement. Appellant respectfully asserts that the excerpt from Vaziri merely teaches that a "user can then record a message and then send it via the SMTP server to the recipient's e-mail address." Vaziri continues, teaching that "[e]ach voice mail

message is stored on the recipient's POP server in the form of an e-mail message." Additionally, Vaziri discloses that the "<u>ISB connects</u> to the ISP and then connects through ISP 706 and Internet 712 <u>to POP server</u> 716" where "the <u>ISB downloads and plays the first message</u>" (emphasis added).

Clearly, sending a recorded message to an SMTP server, storing the message on the POP server, and the ISB downloading and playing the message from the POP server, as in Vaziri, fails to support the Examiner's argument that Vaziri teaches "email messages that are capable of being received at the help desk computer." More importantly, appellant respectfully asserts that the mere disclosure of an ISB that may download and play a message fails to even suggest a "<u>protocol handler block</u> for receiving and handling messages <u>from said user interface **and** from said Internet-ready device</u>," as claimed by appellant (emphasis added). In addition, the disclosure of a SMTP server used to send a recorded message and an e-mail program to check for e-mail similarly fails to even suggest the same.

In the Examiner's Answer mailed 01/31/2007, the Examiner has argued that Vaziri teaches "a user interface, allowing a user to initiate passing information between the Internet-ready device and the Internet (an Internet switch box (ISB) is connected or integrated within the telephone…[and] the ISB takes care of all connection procedures necessary to set up and maintain the Internet telephone call...)…[and] a protocol handler block for receiving and handling messages from the user interface and from the Internet-ready device (the ISB includes PC-compatible microprocessor 201…microprocessor 201 executes software architecture…[including] TCP/UDP driver 2A13, IP driver 2A15 and PP driver 2A17 [which] serve as…embedded networking software for packetizing data and allowing communication with the Internet – see Vaziri, Fig. 2 and 2A, col. 9, line 13 – col. 10, line 13)." Further, the Examiner has argued that "[t]he Vaziri reference teaches the ISB capable of using the TCP/IP protocol suite, as detailed above."

The Examiner has additionally argued that 'Stevens discusses that the TCP/IP protocol suite contains four layers, one of which is the transport layer, which "provides a flow of data between two hosts," one of the transport layer protocols being TCP" and that "[t]hese two hosts are equivalent to appellant's user interface and the Internet, and as communication is passed between

the user interface as the Internet-ready device, the two hosts can also be equivalent to the appellant's apparatus and the Internet-ready device. The Examiner has concluded that Vaziri "teaches a protocol handler block (transport layer) for receiving (acknowledging received packets) and handling messages from the user interface (make certain the other end [the Internet] acknowledges packets that are sent - see Stevens, page 2, "the transport layer," reference attached in the Appendix) and from the Internet-ready device (Vaziri, Fig. 12, element 908; a computer or data terminal 908 and a specially equipped ISB 100HD connected to computer or data terminal via a serial port or other connection…"

Appellant notes the Examiner has relied on the Stevens reference, which constitutes a reference separate from that in the relevant rejection under 35 U.S.C. 102(e), and is thus improper. Further, it is noted that the Examiner fails to cite specific motivation in the relevant reference to support the case for combining the Stevens reference. The Examiner is reminded that the Federal Circuit requires that there must be some logical reason apparent from the evidence of record that would justify the combination or modification of references. In re Regel, 188 USPQ 132 (CCPA 1975). Thus, the reliance on the Stevens reference, on its face, is clearly improper.

In addition, appellant respectfully disagrees with the Examiner's arguments and asserts that Vaziri merely discloses that "FIG. 4 shows the back or bottom view of an ISB" where the "[b]ack or bottom panel 402 can include telephone jack 404 for connection to telephone 211, telephone jack 406 for connection to telephone line 212, optional port (serial, parallel, universal serial bus (USB), etc.) 408 for connection to another device such as a PC, and power jack 410" (Col 12, lines 1-6 – emphasis added). Further, Vaziri discloses that "[i]f the ISB is intended for use with a connection other than to the analog PSTN, such as a connection to an ISDN line or to a cable modem, jack 406 can be modified accordingly" (Col. 12, lines 13-16 – emphasis added). In addition, Vaziri discloses that "[t]he user simply plugs telephone 211 into jack 404, a cord from telephone line 211 into jack 406 and a power adapter into power jack 410 to supply power from a wall outlet" (Col. 12, lines 24-26 – emphasis added).

However, the mere disclosure of an ISB with three ports, one for the telephone line, ISDN line, or cable modem, one for connecting a telephone, and another for connecting to another device such as a PC, as in Vaziri, fail to suggest a "protocol handler block for receiving and handling

messages <u>from said user interface</u> **and** <u>from said Internet-ready device</u>" where "the second port connects to said <u>Internet-ready device</u> capable of communicating utilizing <u>Internet-related protocols</u>," in the context as claimed by appellant (emphasis added). Clearly, the <u>telephone</u> as connected to port 404, as in Vaziri, fails to meet an "<u>Internet-ready device</u> capable of communicating utilizing <u>Internet-related protocols</u>," in the manner as claimed by appellant (emphasis added).

Further, the Examiner has argued that Vaziri "teaches a protocol handler block (transport layer) for receiving (acknowledging received packets) and handling messages from...the Internet-ready device (Vaziri, Fig. 12, element 908; a computer or data terminal 908 and a specially equipped ISB 100HD connected to computer or data terminal via a serial port or other connection...[where] [p]ersonal computers that are multimedia capable in terms of possessing...an adequate modem...as well as an account with an online service provider (ISP) for connection to the Internet – see Vaziri, col. 22, lines 27-33 and col. 1, lines 31-41)." In addition, the Examiner has argued that "[t]he computer could be connected to the ISB via a connection such as a telephone line that would enable use of the modem, which has TCP/IP capabilities" and "[t]hus both the ISB and the personal computer are capable of utilizing a protocol handler block."

Appellant respectfully disagrees with the Examiner's arguments and asserts that Vaziri merely discloses that "FIG. 9 shows a connection between a customer's location 900C and an agent's position 900HD at the help desk" where "[t]he help desk has one or more call center positions 900HD, each equipped with <u>a standard telephone 211HD</u>, <u>a computer or data terminal 908</u> and a specially equipped <u>ISB 100HD connected to computer or data terminal 908 via a serial port or other connection such as serial port 408</u> of FIG. 4" (Col. 22, lines 27-33 – emphasis added). Further, Vaziri discloses that "[t]he ISBs 100C and 100HD perform a modem handshaking and then <u>start a PPP link between them</u>" (Col. 22, lines 55-57 – emphasis added) so that the "[t]he agent can use ISB 100HD to <u>access, program, upgrade and test customer's</u> ISB 100C" (Col. 22, lines 35-37 – emphasis added).

In addition, Vaziri discloses that "Microprocessor 201 executes the software architecture shown in FIG. 2A" where the "[s]oftware architecture 2A01 is based on a space-efficient embedded

operating system such as ROM DOS 2A03, which includes application component 2A05 and maintenance component 2A07... [which] interacts with the following drivers" (Col. 10, lines 1-6). Still yet, Vaziri discloses that the "[t]elephone interface driver 2A09 allows the software to interact with telephone set 211" and "TCP/UDP driver 2A13, IP driver 2A15 and PPP driver 2A17 serve as modifiable, embedded networking software for packetizing data and allowing communication with the Internet" (Col. 10, lines 6-14 – emphasis added).

However, the mere disclosure that the helpdesk ISB has a computer or data terminal connected via the serial port for accessing, programming, upgrading, and testing the customer's ISB via a PPP link established between the help desk ISB and the customer ISB by the PPP driver of Microprocessor 201 that allows for communication over the Internet, as in Vaziri, simply fails to meet a "protocol handler block for receiving and handling messages from said user interface **and** from said Internet-ready device," in the manner as claimed (emphasis added). Clearly, the microprocessor packetizing data and allowing communication with the Internet between the help desk ISB and the customer ISB, as in Vaziri, fail to meet "protocol handler block for receiving and handling messages... **from** said Internet-ready device," in the manner as claimed (emphasis added).

Appellant again emphasizes that Vaziri only teaches that "the ISB connects to the ISP and then connects through ISP 706 and Internet 712 to POP server 716" to download and play the first message and that "the ISB connects to the ISP and then connects through ISP 706 and Internet 712 to SMTP server 718" to send a message (see Col. 17, line 57-Col. 18, line 1). Thus, the ISB only directly receives messages from an ISP and from a telephone connected to the ISB and utilized by the user. Clearly, the ISB in Vaziri is not disclosed to specifically include "a protocol handler block for receiving and handling messages from said user interface **and** from said Internet-ready device, and for sending on said handled messages to a network stack block," let alone where the "user interface...[allows] a user to initiate passing information between said Internet-ready device and said Internet, and [that has] associated indicators to indicate to said user that said passing of information that was initiated by said user in complete," in the context claimed by appellant.

With additional reference to independent Claims 1 and 27, the Examiner has relied on the following excerpt from Vaziri to make a prior art showing of appellant's claimed protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device, and for "sending on said handled messages to a network stack block" (see this or similar, but not identical language in each of the foregoing claims).

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"More specifically, the ISB stores device, server, billing, and owner
information and a friends directory. The device information is
typically programmed into the ISB at the factory and includes the
serial number, the manufacturing date, the hardware version, the
software version, and the feature key, which identifies those features
which the ISB implements. The server information includes the IP
addresses for the various servers which the ISB needs to access, such
as the primary and backup ISBSSs. The owner information includes the
telephone number, the ISP access telephone number, any scripting
required to log onto the ISP, logon name and password, the domain names
or IP addresses for the SMTP and POP servers for e-mail, the e-mail
address, and the e-mail password. The SMTP server implements the simple
mail transfer protocol (SMTP) for sending e-mail, while the POP server
implements the post office protocol (POP) for receiving e-mail. Many
ISPs use the same server for both protocols. Other mail protocols exist
and can be used instead." (Col. 13, lines 13-31)
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Appellant respectfully asserts that the above excerpt from Vaziri only relates to information with respect to the device, server, billing, owner information and friends directory that the Internet switch box (ISB) stores. Further, by virtue of the above arguments, there is not even a suggestion of any sort of <u>messages</u>, let alone sending <u>handled messages from said user interface and from said Internet-ready device</u> to a <u>network stack block</u>, in the manner claimed by appellant.

In the Office Action dated 01/27/2006, the Examiner has argued that such excerpt in Vaziri teaches that "the ISB stores server information…the server information includes the IP address for various servers which the ISB needs to access…the domain names or IP addresses for the SMTP and POP servers for e-mail…the SMTP server implements the simple mail transfer protocol (SMTP) for sending e-mail, which the POP server implements the post office protocol (POP) for receiving e-mail." Appellant again respectfully disagrees and asserts that the ISB only stores "device, server, billing, and owner information and a friends directory," none of which meet any sort of "sending on said <u>handled messages</u>," as appellant specifically claims (emphasis added).

-10-

In the Advisory Action mailed 03/30/2006, the Examiner has again relied upon Col. 13, lines 13-31 to make a prior art showing of appellant's claimed technique. However, Vaziri's disclosure of using SMTP "for sending e-mail" and POP "for receiving e-mail" fails to meet "sending on said handled messages [from said user interface and from said Internet-ready device] to a network stack block," as claimed by appellant (emphasis added). In addition, the Examiner relied upon Col. 2, line 8 and the mere disclosure of packets being sent over the Internet using TCP/IP. Appellant asserts that the Examiner's argument that "[a] network stack block is inherent in the TCP/IP protocol" still fails to take into consideration the full weight of appellant's claim language, namely "sending on said handled messages," in the context claimed (emphasis added).

In the Examiner's Answer mailed 01/31/2007, the Examiner has argued that "the Vaziri reference teaches the ISB capable of using the TCP/IP protocol suite" and that 'Stevens discusses that the TCP/IP protocol suite contains four layers, one of which is the network layer, which "handles the movement of packets around the network," one of the network layer protocols being IP.' The Examiner has further argued that 'Stevens teaches "every piece of TCP… data that gets transferred around the internet goes through the IP layer."'

Appellant respectfully disagrees. Specifically, appellant again respectfully notes the Examiner has relied on the Stevens reference, which constitutes a reference separate from those in the relevant rejection under 35 U.S.C. 102(e), and that the Examiner fails to cite specific motivation in the relevant reference to support the case for combining the Stevens reference. Thus, the reliance on the Stevens reference, on its face, is clearly improper. Additionally, appellant respectfully points out that teaching that an ISB includes a microcontroller that executes a TCP/UDP driver, as in Vaziri, fails to meet "sending on said handled messages [from said user interface and from said Internet-ready device] to a network stack block," as claimed by appellant (emphasis added).

Still with respect to independent Claims 1 and 27, the Examiner has relied on Figure 3 elements 304, 306, 307, and 311 along with Col. 11, lines 11-22 in Vaziri to make a prior art showing of appellant's claimed "indicators to indicate to said user that said passing of information that was

initiated by said user is complete." Appellant emphasizes, however, that in the Office Action dated 11/03/05, the Examiner admitted that Vaziri did not teach such claim language (see page 5 of the foregoing Office Action).

Nevertheless, appellant respectfully asserts that Vaziri expressly discloses that elements 304, 306, 307 and 311 are LEDs located on the ISB, and that such "LEDs may be used to indicate whether the power is on or off, the status of an Internet call attempt and whether any messages are waiting" along with "whether the menu feature is in use or whether an upgrade to the ISB software is available." Clearly, none of the functions taught by Vaziri meet appellant's claimed "indicators to indicate to said user that said passing of information that was initiated by said user is complete," as claimed (emphasis added).

In the Advisory Action mailed 03/30/2006, the Examiner argued that items 304, 306, 307, and 311 of Figure 3 and Col. 11, lines 11-22 disclose "status indicator LEDs...[which] may be used to indicate the status of an Internet call attempt." See below:
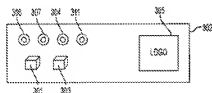

FIG. 3

"FIG. 3 shows a front or top view of an ISB. Front or top panel 302 may include a logo 305. Status indicator LEDs 304, 306, 307 and 311 may be provided. **Three of these LEDs may be used** to indicate whether the power is on or off, **the status of an Internet call attempt** and whether any messages are waiting. The fourth can be used in various ways, such as to indicate whether the menu feature is in use or whether an upgrade to the ISB software is available (in which case the software can be upgraded in a manner to be described below). Of course, other configurations of LEDs can be used, as can other interfaces such as an alphanumeric LCD display." (Col. 11, lines 11-22 – emphasis added)

However, the mere disclosure of status indicator LEDs of which one may be used to indicate "the status of an Internet call attempt" fails to even suggest "indicators to indicate to said user that said passing of information that was **initiated by said user** is complete," as claimed by appellant (emphasis added).

In the Examiner's Answer mailed 01/31/2007, the Examiner has again argued that Col. 11, lines 11-22 and Fig. 3, elements 304, 306, 307, and 311 teach that "[s]tatus indicator LEDs may be provided" and that "[t]hree of these LEDs may be used to indicate… whether any messages are waiting… to indicate to said user that said passing of information that was initiated by the user is complete." The Examiner has also argued that Col. 18, lines 5-10 teaches that "the ISB can be configured to poll the ISP periodically (programmed by the user) to check for message [sic] and to give an indication to the user via an LED or the like when messages are waiting."

Appellant disagrees and respectfully points out that the excerpts from Vaziri relied upon by the Examiner simply teach that "[t]hree of these LEDs may be used to indicate… the status of an Internet call attempt and whether any messages are waiting" (col. 11, lines 13-16 – emphasis added). Additionally, the excerpts teach that "[t]he ISB can also be configured to poll the ISP periodically… to check for message and to give an indication to the user via an LED or the like when messages are waiting" (Col. 18, lines 5-10). However, the mere disclosure of status indicator LEDs which may be used to indicate "the status of an Internet call attempt" and "whether any messages are waiting," as in Vaziri, fail to even suggest "indicators to indicate to said user that said passing of information that was **initiated by said user** is complete," as claimed by appellant (emphasis added). Clearly, an LED indicating that messages for the user are waiting, as in Vaziri, fails to suggest that "said passing of information that was initiated by said user is complete," in the manner as claimed by appellant (emphasis added).

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Vaziri reference, as noted above.

   Group #2: Claim 52

-13-

With respect to independent Claim 52, the Examiner has relied on the following excerpts from Vaziri to make a prior art showing of appellant's claimed "user interface block [used] to connect to said Internet-ready device" (see Claim 52).

> "A relatively inexpensive interface device, referred to as an Internet switch box (ISB), is connected to or integrated within the telephone. While the user must possess access to the Internet either directly or via an Internet Service Provider (ISP) in order to use the ISB, the user will not be subject to toll charges other than those incurred using the PSTN to establish the Internet telephone call. The user does not need to understand how a computer works or how to use any PCIT software, since the ISB can be preprogrammed to dial an ISP and to connect via SLIP or PPP. The user need only know how to dial the call using normal PSTN dialing procedures and then simply switch the call to an Internet connection, if available and desirable. Other than the user pressing a button (either on the ISB or telephone keypad) to initiate the Internet telephone call, the ISB takes care of all connection procedures (i.e., handshaking) necessary to set up and maintain the Internet telephone call. While both..." (Col. 3, lines 21-37)

> "As indicated, an ISB may be incorporated into a telephone or be a standalone adjunct device connected between the telephone and the telephone line. Additionally, ISB's may be..." (Col. 3, lines 64-66)

> "FIG. 4 shows the back or bottom view of an ISB. Back or bottom panel 402 can include telephone jack 404 for connection to telephone 211, telephone jack 406 for connection to telephone line 212, optional port (serial, parallel, universal serial bus (USB), etc.) 408 for connection to another device such as a PC, and power jack 410." (Col. 12, lines 1-6; see also Figure 4)

In the Office Action dated 01/27/2006, the Examiner has responded to appellant's arguments by relying on Vaziri's disclosure of a help desk computer or data terminal (item 908 of Figure 9) to meet appellant's claimed "Internet-ready device." Appellant respectfully asserts that, if the Examiner now relies on the help desk computer of Vaziri to meet appellant's claimed "Internet-ready device," the remaining claim elements are simply not met.

Specifically, the help desk computer in Vaziri uses an Internet switch box (ISB) to connect to the Internet. As shown in Figure 9, the ISB 100HD is separate from the help desk computer 908. Furthermore, Vaziri even discloses that the "specially equipped ISB 100HD [is] connected to [the] computer or data terminal 908 via a serial port or other connection such as serial port 408 of Figure 4" (see Col. 22, lines 27-33). Appellant notes that Vaziri only teaches that the ISB may

-14-

be "incorporated into a telephone," but not within the help desk computer (see Col. 3, lines 21-23 and 64-66). Thus, Vaziri does not teach an "apparatus for a user to connect to an Internet-ready device to the Internet, where said apparatus is embedded into said Internet-ready device" and where the apparatus comprises "a user interface block to connect to said Internet-ready device," as claimed by appellant (emphasis added).

In the Advisory Action mailed 03/30/2006, regarding appellant's claimed "apparatus for a user to connect to an Internet-ready device to the Internet, where said apparatus is embedded into said Internet-ready device" (emphasis added), the Examiner cites Larson below from the MPEP.

> *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.").

The Examiner goes on to argue that "[b]ecause the Internet-ready device and the apparatus have the same functionality whether the apparatus is embedded in the Internet-ready device or not, the rejection stands."

Appellant respectfully disagrees with such assertion. First, attention is directed to Schenck below.

> *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.)."

Appellant notes that the claimed apparatus does not have the same functionality whether the apparatus is embedded in the Internet-ready device or not, as purported by the Examiner. As

-15-

indicated in the Background of the originally filed specification, many problems exist when using an apparatus in conjunction with a separate Internet-ready device. As further set forth in the originally filed specification, the claimed invention is thus cost affordable to embed into other devices, etc. Thus, like Schenck, appellant's novel integrated feature shows insight that was contrary to the understandings and expectations of the prior art, for the reasons noted above.

In the Examiner's Answer mailed 01/31/2007, the Examiner cites in re Hirao below and asserts that 'the recitation "an apparatus for a user to connect to an Internet-ready device to the Internet, wherein said apparatus is embedded into said Internet-ready device" has not been given patentable weight because the recitation occurs in the preamble.'

> In re Hirao, 535 F. 2d 67, 190 USPQ 15 (CCPA 1976) "[a] preamble is generally not accorded any patentable weight where it <u>merely recites</u> <u>the purpose of a process or the intended use of a structure</u>, and where the body of the claim <u>does not depend on the preamble for completeness</u> but, instead, the process steps or structural limitations are able to stand alone" (emphasis added).

Appellant disagrees and respectfully points out that the preamble in Claim 52 does more than merely recite the purpose or intended use of the claimed apparatus by requiring such apparatus to be "embedded into said Internet-ready device," as claimed by appellant. Additionally, appellant notes that the body of the claim does in fact depend on the preamble for completeness, as the phrase "wherein said apparatus is embedded into said Internet-ready device," as claimed by appellant, unquestionably modifies appellant's claimed "apparatus for a user to connect an Internet-ready device to the Internet." As a result, *In re Hirao* does not apply, and the preamble should be given patentable weight.

Also, attention is drawn to *In re Stencil,* 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987), which states that, [i]n claims directed to articles and apparatus, any phraseology in the preamble that limits the structure of that article or apparatus must be given weight." As noted above, appellant's claimed <u>embedded into said Internet-ready device</u> (in the preamble) clearly limits the structure of the claimed apparatus in a way that is novel over the prior and which addresses the previously discussed problems with the prior art. Again, the preamble should be given patentable weight. It is also noted that the emphasized limitations set forth above have yet to be adequately addressed by the Examiner, per the arguments set forth hereinabove.

Also in the Examiner's Answer mailed 01/31/2007, the Examiner has argued that "Vaziri teaches an apparatus for a user to connect to an Internet-ready device (Fig. 4 shows the back or bottom view of an ISB [...where the] [b]ack or bottom panel can include...telephone jack 406 for connection to telephone line...408 for connection to another device such as a PC – see Vaziri, Fig. 4, elements 406 and 408; col. 12, lines 1-6) to the Internet (an Internet switch box (ISB) is connected to or integrated within the telephone...other than the user pressing a button (either on the ISB or telephone keypad) to initiate the Internet telephone call, the ISB takes care of all connection procedures necessary to set up and maintain the Internet telephone call – see Vaziri, col. 3, lines 21-37)."

Appellant respectfully disagrees and asserts that Vaziri merely discloses that "[o]ther than the user pressing a button (either on the ISB or telephone keypad) to initiate the Internet telephone call, the ISB takes care of all connection procedures (i.e., handshaking) necessary to set up and maintain the Internet telephone call" (Col. 3, lines 33-35 – emphasis added). However, the mere disclosure that the user presses a button on the ISB or the telephone keypad to initiate the Internet telephone call, as in Vaziri, simply fails to even suggest "a user interface block [used] to connect to said Internet-ready device" (emphasis added), as claimed by appellant. Clearly, the user pressing a button to initiate the Internet telephone call, as in Vaziri, fails to suggest "connect[ting] to said Internet-ready device," in the manner as claimed by appellant (emphasis added).

Again, the foregoing anticipation criterion has simply not been met by the above reference, as noted above.

　　　Group #3: Claims 11 and 37

With respect to Claim 11 et al., the Examiner has relied on Col. 3, lines 64-66 in Vaziri to make a prior art showing of appellant's claimed apparatus "added easily to any of, but not limited to: set-top-boxes; Ethernet hubs; and hubs that are attached to new home networking standards." Appellant respectfully asserts that such excerpt only teaches that the "ISB may be incorporated into a telephone." Clearly, a telephone, as solely disclosed in Vaziri, does not meet appellant's

claimed "set-top-boxes; Ethernet hubs; and hubs that are attached to new home networking standards."

In the Advisory Action mailed 03/30/2006, the Examiner argued that Col. 3, lines 64-66 in Vaziri teaches a "standalone adjunct device." However, appellant respectfully disagrees and asserts that Vaziri discloses "an ISB [which] may be incorporated into a telephone or be a standalone adjunct device connected between the telephone and the telephone line" (emphasis added). Clearly, a standalone device connected between a telephone and telephone line fails to even suggest "set-top-boxes; Ethernet hubs; and hubs that are attached to new home networking standards," as claimed by appellant.

In the Examiner's Answer mailed 01/31/2007, the Examiner has argued "that Vaziri teaches the use of an ISBSS which is a server that provides connection information for ISBs" and states that 'the IEEE Authoritative Dictionary of IEEE Standards Terms defines a "hub" as "a device to provide connectivity between data terminal equipments"' and that "in the broadest reasonable interpretation in light of the supporting disclosure, Vaziri teaches the apparatus (an ISB) added (connected) to an Ethernet hub." The Examiner has further relied on the following excerpt from Vaziri to make a prior art showing of appellant's claim language.

> "...language. The primary purpose of the ISBSS, but not the exclusive
> function, is to provide connection information for two ISBs to engage
> in an IT call, since it is contemplated that the ISBs will not exchange
> information during the PSTN portion of the call. In addition, the ISBSS
> documents each completed call and each request for any other service,
> such as voice messaging and software upgrade requests, requested from
> ISBs and supported by the vendor of the ISBs.
>
> The ISBSS is an iterative server. The server functions can..." (Col.
> 18, lines 40-49)

Appellant disagrees with the Examiner's arguments and respectfully asserts that the excerpt relied on by the Examiner merely teaches that an ISBSS "provide[s] connection information for two ISBs to engage in an IT call" (emphasis added). Additionally, Vaziri discloses that "[t]he ISBSS is an iterative server" (Col. 18, line 49 – emphasis added). Simply disclosing that a server provides connection information for two ISBs, as in Vaziri, fails to teach an apparatus "added easily to any of, but not limited to: set-top-boxes; Ethernet hubs; and hubs that are attached to

-18-

new home networking standards," as claimed by appellant (emphasis added). For example, an iterative service that provides connection information, as in Vaziri, simply fails to meet an "Ethernet hub," in the manner as claimed by appellant.

Again, the foregoing anticipation criterion has simply not been met by the above reference, as noted above.

Issue # 4:

The Examiner has rejected Claims 13-16, and 39-42 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Himmel et al. (U.S. Patent No. 6,480,852).

     Group #1: Claims 13-14 and 39-40

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of the arguments made hereinabove with respect to the Issue #3, Group #1.

     Group #2: Claims 15 and 41

With respect to Claim 15 et al., the Examiner has relied on Col. 14, line 55-Col. 15, line 2 in Vaziri to make a prior art showing of appellant's claimed "key code for passing from said Internet-ready device to said Internet, whereupon a pre-agreed upon algorithm is used to generate a response, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device."

Appellant respectfully asserts that such excerpt only generally teaches that the "ISB and the ISP perform any authentication procedure required" and that "the ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before." Clearly, only generally mentioning an authentication procedure and a default password authentication protocol, as in Vaziri, does not meet appellant's specific claim language, namely that "a <u>pre-agreed upon algorithm is used to generate a response</u>, whereupon said response is sent back to said Internet-ready device, thereby

-19-

authenticating said Internet connection to said Internet-ready device," as claimed by appellant (emphasis added).

In the Advisory Action mailed 03/30/2006, the Examiner again argued that Col. 14, lines 55-66 in Vaziri discloses appellant's claimed technique of "a pre-agreed upon algorithm [that] is used to generate a response."

> 'Connection to the ISP will now be explained with reference to FIG. 7B. The modem is initialized, and telephone line 212 is monitored for a dial tone. ISB 100 dials the ISP access number to connect via PSTN 702 to modem rack 704 of the ISP. The modem of the ISB and a modem reached in modem rack 704 negotiate the baud rate and the protocol, whereupon ISB 100 is connected to the facilities of ISP 706. **The ISB and the ISP perform any authentication procedure required,** and the ISB selects "PPP" from the ISP's logon menu, if any. **The ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before.** The ISB is then connected by TCP to the ISP and thus via line 708, such as a T1 or T3 line or the like, to Internet backbone 710. If the call to the ISP results in a busy signal, the user can simply wait and call again. Alternatively, the ISB can be configured to store and dial multiple access numbers for one or more ISPs.' (Col. 14, lines 55-66 - emphasis added)

Appellant respectfully asserts that the excerpt from Vaziri relied upon by the Examiner merely discloses that "[t]he ISB and the ISP perform any authentication procedure required" (emphasis added). Further, Vaziri discloses that "[t]he ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before" (emphasis added). However, the mere disclosure that the ISB and the ISP perform authentication and PAP if no authentication has been performed before fails to even suggest a "key code for passing from said Internet-ready device to said Internet, whereupon a pre-agreed upon algorithm is used to generate a response, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device," as claimed by appellant (emphasis added). Clearly, Vaziri's disclosure of using PAP fails to even suggest a technique "whereupon a pre-agreed upon algorithm is used to generate a response," as claimed by appellant.

In the Examiner's Answer mailed 01/31/2007, the Examiner has simply repeated the previous grounds of rejection. Appellant respectfully disagrees and again asserts that the excerpt in Vaziri

relied on by the Examiner only generally teaches that the "ISB and the ISP perform any authentication procedure required" and that "the ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before." However, generally mentioning an authentication procedure and a default password authentication protocol, as in Vaziri, does not meet appellant's specific claim language, namely that "a <u>pre-agreed upon algorithm is used to generate a response</u>, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device," as claimed by appellant (emphasis added). Clearly, the disclosure of using PAP if no prior authentication has been performed, as in Vaziri, fails to suggest "a <u>pre-agreed upon algorithm</u> is used to generate a response," in the manner as claimed by appellant (emphasis added).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest <u>all</u> of the claim limitations, as noted above.

    Group #3: Claims 16 and 42

With respect to Claim 16 et al., the Examiner has again relied on Col. 14, line 55-Col. 15, line 2 in Vaziri to make a prior art showing of appellant's claimed "used in reverse to prevent unauthorized Internet-ready devices from accessing a particular site." Appellant respectfully asserts that such excerpt from Vaziri only relates to authenticating an ISB with an ISP, and not

"to prevent unauthorized Internet-ready devices from accessing a particular <u>site</u>," as appellant claims (emphasis added).

In the Advisory Action mailed 03/30/2006, the Examiner argued that "[i]t is inherent that if a user cannot be authenticated, then he or she is not authorized to access any site." Appellant respectfully asserts that the Examiner's inherency argument for authentication fails to even address the full weight of appellant's claimed technique "used in reverse to prevent unauthorized Internet-ready devices from accessing a particular site." Clearly, the mere disclosure of PAP during authentication, fails to even suggest "prevent[ing] unauthorized Internet-ready devices from accessing <u>a particular site</u>," as claimed by appellant (emphasis added).

In the Examiner's Answer mailed 01/31/2007, it appears as though the Examiner is simply relying on an inherency argument by stating that "[l]ogging on to an ISP usually results in the user being presented with a homepage" and "[i]f during the authentication procedure between the ISB and the ISP, the ISB is not granted access to the ISP… the ISB is not permitted to logon to the ISP, and thus the ISB will not be presented with the ISP homepage (a particular site)."

Appellant respectfully disagrees. In particular, appellant respectfully asserts that the excerpt from Vaziri relied on by the Examiner teaches that "[t]he ISB and the ISP perform any authentication procedure required, and… [t]he ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before" where "[t]he ISB is then connected by TCP to the ISP." Nowhere in the cited excerpt does Vaziri mention the user being presented with a homepage after being authenticated, much less appellant's claimed apparatus "used in reverse <u>to prevent unauthorized Internet-ready devices from accessing a particular site</u>," as claimed by appellant (emphasis added). Furthermore, merely disclosing that the ISB and ISP perform PAP if no authentication has been performed, as in Vaziri, simply fails to even suggest "prevent[ing] unauthorized Internet-ready devices from accessing a <u>particular site</u>," in the manner as claimed by appellant (emphasis added).

It appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. In view of the arguments made hereinabove, any such inherency

argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Issue # 5:

The Examiner has rejected Claims 17 and 43 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Himmel in view of Martin et al. ("An Alternative to Government Regulation and Censorship: Content Advisory Systems for the Internet").

   Group #1: Claims 17 and 43

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of the arguments made hereinabove with respect to Issue #3, Group #1.

Issue # 6:

The Examiner has rejected Claim 58 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Sharpe, III et al. (U.S. Patent No. 6,012,961).

   Group #1: Claim 58

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of the arguments made hereinabove with respect to the independent Issue #3, Group #1.

Issue # 7:

The Examiner has rejected Claim 59 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Reavey et al. (U.S. Patent No. 5,847,698).

Group #1: Claim 59

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of the arguments made hereinabove with respect to Issue #3, Group #1.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NVIDP322/P001314).

Respectfully submitted,

By: ___/KEVINZILKA/_____   Date: _____April 2, 2007_____

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